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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,844	02/13/2002	Luc D'herbemont	2-2-2-27	9031

7590 12/28/2005

Docket Administrator (Room 3J-219)
Lucent Technologies Inc.
101 Crawfords Corner Road
Holmdel, NJ 07733-3030

EXAMINER

TON, DANG T

ART UNIT	PAPER NUMBER
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2666

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/075,844	Applicant(s) D'HERBEMONT ET AL. aa	
	Examiner DANG T. TON	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

2. Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2 line 2, " the international mobile subscriber identity " has no antecedent basis.

in claim 4 line 3, " such as GSM-MAP or DS-41" is vague and indefinite since it is not known applicants intend to claim it or not.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because

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the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,738,632. Although the conflicting

claims are not identical, they are not patentably distinct from each other because of the following formalities:

For claims 1-5, the claim 6 of U.S. Patent No. 6,738,632 disclose a system comprising a core network communicating by means of a UTRAN network with a plurality of user equipment, the core network comprising a mobile switching center and at least one serving GPRS support node, each user equipment being able to work selectively in two operating modes, firstly a connected mode in which the resources of the system are allocated to setting up a connection between the user equipment and the mobile switching center and/or at least one serving GPRS support node, and secondly an idle mode, characterized in that the mobile switching center and the at least one serving GPRS support node communicate by means of an interface, the interface being designed to give the at least one serving GPRS support node the identity of the user equipment in the connected mode with the mobile switching center, and in that, to page one of the user equipment in the connected mode with the mobile switching center, the at least one serving GPRS support node communicates with the one user equipment through the mobile switching center, further characterized in that the interface is furthermore designed to give the at least one serving GPRS support node the

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identity of radio network controllers with which the mobile switching center is linked to communicate with the user equipment in the connected mode, and in that, to page one of the user equipment in the connected mode with the mobile switching center, the at least one serving GPRS support node directly communicates with a concerned serving radio network controller instead of going through the mobile switching center.

Note: See the claim 6 of U.S. Patent No. 6,738,632.

Applicant's claims 1-5 merely broaden the scope of the claim 6 of U.S. Patent No. 6,738,632 by eliminating the terms "to page one of the user equipment in the connected mode with the mobile switching center, the at least one serving GPRS support node communicates with the one user equipment through the mobile switching center, further characterized in that the interface is furthermore designed to give the at least one serving GPRS support node the identity of radio network controllers with which the mobile switching center is linked to communicate with the user equipment in the connected mode, and in that, to page one of the user equipment in the connected mode with the mobile switching center, the at least one serving GPRS support node directly communicates with a concerned serving radio network controller instead of going through the

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mobile switching center" from claim 6 of the patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not need would be obvious to one skilled in the art.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by XP-002168551 (Universal Mobile telecommunications System (UMTS); RRC Protocol Specification).

For claims 1-5, XP-002168551 disclose an Universal Mobile telecommunications System (UMTS) comprising :

a user equipment device of a mobile radio telecommunications system, the user equipment device working selectively in two modes of operation (see GSM mode and GPRS mode in figure 5), a

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connected mode in which resources of the system are allocated to setting up a connection with the user equipment device and an idle mode (see idle mode in figure 5), the user equipment device being identified in idle mode by a first identity and in connected mode by a second identity, characterized in that the user equipment device in connected mode is capable of processing messages in which it is identified by its first identity (see RRC connections in figure 5);

wherein the first identity of the user equipment is the international mobile subscriber identity or a temporary mobile subscriber identity for a circuit switch service or a packet temporary mobile subscriber identity (see and GPRS mode in figure 5);

wherein the second identity is a UTRAN network temporary identity (see UTRA connected mode in figure 5); and

wherein the first identity of the user equipment is an identity applicable in any type of public land mobile network such as GSM-MAP or DS-41 (see GSM mode in figure 5).

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hogan (2002/0151304) and Amirijoo et al. (2003/0050097) are all cited to show systems which are considered pertinent to the claimed invention.

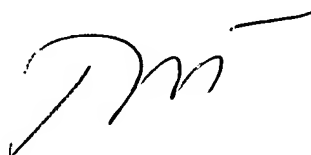
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T. TON whose telephone number is 571-272-3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton



DANG TON
PRIMARY EXAMINER